

Redd, et al.  
Application No.: 10/627,393

## REMARKS

### THE OATH/DECLARATION REJECTION

Applicants' petition filed on 7/7/2004 reciting the current Application Serial Number 10/627,393 in compliance with 37 CFR 1.67(a) was granted on 9/10/2004.

In response to the Office Action of 9/3/2004, a Supplemental Oath and Declaration was filed on 9/16/2004 under 37 CFR §1.67(b) to properly identify the current Application Serial Number 10/627,393 and the parent Application Serial Number 09/450,899 for claiming of priority to the parent application. A copy of the Supplemental Oath and Declaration is attached.

Applicants believe that these actions have properly addressed the defective portions of the original Oath and Declarations.

### THE SECTION 103 REJECTION

The Office Action mailed 9/3/2004 rejected claims 1,2, 4-8 9-14 under 35 USC 103(a) as being unpatentable over Fredlund (US 6,154,295). Claims 3 and 10 are rejected under 35 USC 103(a) as being unpatentable over Fredlund (US 6,154,295), and further in view of Garfinkle et al (US 6,570,640), William et al (US 6,388,732) or Nozaki et al. (US 6,349,194).

In response, Applicants have amended the claims. The amended claim limitations are supported by disclosures on Page 27, lines 12-18 of the specification:

"...non-image information may be printed on the back (i.e., non-image side) of an image print 920 and may include a unique identification number 922 for the image from which the print was made (i.e., an "image ID" number), a unique order identification number 924 (which may encode recipient information), reorder information 926 such as a phone number 928 and/or a URL 930 for a website from which prints can be reordered, a bar code 932 (encoding, for example, an audio message or processing data), and/or a user specified message 934."

disclosures on Page 21, lines 13-15, of the specification:

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"With regard to the former (ordering additional prints), each print could be encoded on its back or front with a print re-order number that uniquely identifies the print and/or the particular recipient of the print."

and other sections of the instant application.

5           An advantage of printing re-order information on the back of the image print is that the re-order information can be specific to the image print itself, rather than generally directed to an order. The print size (e.g. 4"x6" or 8"x10"), image processing (e.g. color or tone changes), and image enhancement (e.g. image borders added or not) for image prints may differ even the image prints are based on the same original image. Another advantage of  
10       printing re-order information on the back of the image print is that the re-order information can be specific to the image file that the image print is based. Yet another advantage of printing re-order information on the back of the image print is that the re-order information will not get lost even when the prints from an order are separated from the index print.

15           Applicants submit that none of the references show claim 8 producing image prints having customized message from a user to a recipient by providing an image; receiving a customized message in association with the image, wherein the message includes reorder information; printing the image on the front side of a paper substrate to produce an image print; printing the customized message on the back side of the paper substrate; and sending the image print having the customized message to the recipient.

20           Fredlund discloses a method for remotely selecting and ordering photographic prints, including the steps of: sending a photographic film bearing a plurality of latent images to a photofinisher; developing the photographic film to produce visible images and scanning the visible images to create a digital image file at the photo finisher; producing an index print having a plurality of images from the photographic film along with an index number  
25       associated with each image and an order number; sending the index print to a customer; selecting images for which prints are desired from the index print; ordering photographic prints via telephone from the customer's home to the photofinisher, specifying the order number and the index numbers associated with the images for which prints are desired; and

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making photographic prints of the selected images at the photofinisher and sending the photographic prints to the customer.

Figure 2 of Fredlund shows an index print 32 including the customer order number 34 that identifies the digital image file from which the index print was made, and a series of images 36, each having an associated index number 37. The customer order number 34 is printed on the image side of the index print, that is, the same side on which the index images are also printed. Fredlund does not teach printing re-order information on the back of the image print. Neither does Garfinkle, William, or Nozaki teach printing re-order information on the back of the image print.

Moreover, printing re-order information on the back of an image print in the instant application produces results that are unexpected and unachievable by printing customer order number on the front of the index print in Fredlund, because 1) the instant application can be specific to each image print and image file, Fredlund cannot; 2) the instant application can provide reordering information even when the image prints from an order are separated from the index print but Fredlund cannot.

In sum, the references cannot render claim 8 obvious. Further, the references cannot render any claims dependent from claim 8 obvious. Withdrawal of the rejection is requested.

In view of the amendment and the arguments below, Applicants respectfully submit that all remaining claims are in condition for allowance.

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CONCLUSION

Applicants believe that the above discussion is fully responsive to all grounds of rejection set for the in the Office Action.

5 If for any reasons the Examiner believes a telephone conference would in any way expedite resolution of the issues raised in this appeal, the Examiner is invited to telephone the undersigned at 650-610-3522.

Respectfully submitted,

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Xin Wen

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